



06/25/04

PATENT MAINTENANCE
DIVISION # 307

PATENT
2004 JUL -2 PM 3:26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/066,519
Filing Date: 01/31/2002
Applicant: Troy Walters et. al.
Group Art Unit: 3732
Examiner: Anuradha Ramana
Title: APPARATUS AND METHOD FOR MANIPULATING A
FLEXIBLE STRAND AND SOFT TISSUE REPLACEMENT
DURING SURGERY
Attorney Docket: 5490-000269

Director of The United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

**REQUEST FOR REFUND
(IMPROPER CHARGE OF DEPOSIT ACCOUNT)**

I. REFUND REQUEST

This is a request for a refund, with respect to the charge to Deposit Account No. 08-0750, shown on the statement dated December 31, 2003 (see Attachment A), for the above-identified application.

II. FEES CHARGED FOR WHICH REFUND REQUESTED

Applicants request a refund in the amount of \$950.00 charged to the above-referenced deposit account for a three month extension of time fee.

III. EXPLANATION OF WHY CONTESTED CHARGE IS IN ERROR

This Request for Refund is being made because the Office Action Summary set a statutory period for reply at three months from the date of mailing of the communication (see Attachment B). The mailing date was September 30, 2003. Therefore, the shortened statutory period of three months would have been December 30, 2003.

A reply to the Office Action mailed September 30, 2003 was mailed, with a Certificate of Mailing on December 17, 2003 (see Attachment C). A return postcard was date stamped December 17, 2003 from the U.S. Patent and Trademark Office (see Attachment D).

Therefore, because the shortened statutory period set by the Office Action Summary of three months had not expired upon the mailing and receipt of the response, that being December 17, 2003, no extension of time fee was due. Therefore, the three month extension of time fee was incorrectly debited from the deposit account, noted above, and should be refunded thereto, as requested herein.

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IV. MANNER OF REFUND

Please make the requested refund by crediting Account No. 08-0750 in the amount of \$950.00. If you should have any questions or comments, please do not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 6/24/2004

By: 

Michael L. Taylor
Reg. No. 50,521

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

MLT/lkj

CLERK OF COURT
DIVISION

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UNITED STATES
PATENT AND
TRADEMARK OFFICE



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MONTHLY STATEMENT OF DEPOSIT ACCOUNT

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Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.uspto.gov

To replenish your deposit account, detach and
return top portion with your check. Make check
payable to Director of Patents & Trademarks.

HARNESS DICKEY & PIERCE, P.L.C.

FINA

P O BOX 828

BLOOMFIELD HILLS MI 48013

Account No.	080750
Date	12-31-03
Page	5

PLEASE SEND REMITTANCES TO:
U. S. Patent and Trademark Office
P.O. Box 70541
Chicago, IL 60673

DATE POSTED			CONTROL NO.	DESCRIPTION (Serial, Patent, TM, Order)	DOCKET NO.	FEE CODE	CHARGES/ CREDITS	BALANCE
MO.	DAY	YR.						
12	29	03	93	10083167	9858-000029	1201	735.00	21743.00
12	29	03	95	10083167	9858-000029	1202	738.00	21005.00
12	29	03	415	10613921		8021	40.00	20965.00
12	30	03	3	2636818	8951-500036	8521	40.00	20925.00
12	30	03	4	2636818	8951-500036	8522	2550.00	18375.00
12	30	03	5	10676131	40770-000152/US/DVA	1203	290.00	18085.00
12	30	03	9	2048977	8951-500036	8521	40.00	18045.00
12	30	03	10	2048977	8951-500036	8522	1650.00	16395.00
12	30	03	13	0964779	8951-500036	8521	40.00	16355.00
12	30	03	14	0964779	8951-500036	8522	3825.00	12530.00
12	30	03	15	2331098	8951-500036	8521	40.00	12490.00
12	30	03	16	2331098	8951-500036	8522	2225.00	10265.00
12	30	03	17	0964779	8951-500036	8521	40.00	10225.00
12	30	03	18	0964779	8951-500036	8522	3825.00	6400.00
12	30	03	19	2331098	8951-500036	8521	40.00	6360.00
12	30	03	20	2331098	8951-500036	8522	2225.00	4135.00
12	30	03	21	0964779	8951-500036	8521	40.00	4095.00
12	30	03	22	0964779	8951-500036	8522	3825.00	270.00
12	30	03	81	60524753		8021	40.00	230.00
12	30	03	93	10376633	2421000012US	8007	40.00	190.00
12	30	03	117	78275915	9808300169	8507	90.00	100.00
12	30	03	131	10372218	FD4065	8007	20.00	80.00
12	30	03	140	PAYMENT		9203	-34730.00	34810.00
12	30	03	177	10342304	9432000209	8007	40.00	34770.00
12	31	03	1	10267650	3017/3/US	1814	110.00	34660.00
12	31	03	2	10066519	5490-000269	1253	950.00	33710.00
12	31	03	9	10163691	5077-000114	1801	770.00	32940.00
AN AMOUNT SUFFICIENT TO COVER ALL SERVICES REQUESTED MUST ALWAYS BE ON DEPOSIT					OPENING BALANCE	TOTAL CHARGES	TOTAL CREDITS	CLOSING BALANCE
					31290.00	51532.00	53182.00	32940.00

VS020A (2/2003)

Attachment A

*** O.D. INDICATES OVERDRAWN

2440-000269

12/30/03

Office Action Summary



Application No.

10/068,519

Examiner

Anu Ramana

Applicant(s)

PATENT MAINTENANCE
WALTERS ET AL DIVISION

Art Unit

3732

correspondence address -

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is FINAL.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National St application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application from the International Bureau (PCT Rule 17.2(a))).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- ☐ Interview Summary (PTO-413) Paper N
- ☐ Notice of Informal Patent Application (I
- ☐ Other:

Office Action Summary

Attachment B

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Application/Control Number: 10/066,519
Art Unit: 3732

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:
Claims 1-23, drawn to an apparatus to position tissue in a bone, classified in class

- I. Claims 1-23, drawn to an apparatus to position tissue in a bone, classified in class 606, subclass 96.
- II. Claims 24-36, drawn to a kit for performing surgery in a bone, classified in class 606, subclass 87.
- III. Claims 37-46, drawn to a method of surgically attaching a soft tissue replacement to a bone, classified in class 606, subclass 53.

The inventions are distinct, each from the other because of the following reasons:
Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination claimed because it can be used for performing surgery in a bone, such as drilling.

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by a materially different apparatus or by hand, or (2) the apparatus as claimed can be practiced by another and materially different process. (MPEP § 806.05(e)). In the instant case, the process as claimed can be practiced by a materially different apparatus not having the particular features of the invention or by another apparatus to practice the process, the process as claimed can be practiced by a materially different apparatus not having the particular features of the invention.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different process. (MPEP § 806.05(e)). In the instant case, the process as claimed can be practiced by a materially different apparatus not having the particular features of the invention or by another apparatus to practice the process, the process as claimed can be practiced by a materially different apparatus not having the particular features of the invention.

Application/Control Number: 10/066,519
Art Unit: 3732

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

ber 28, 2003

EDUARDO C. ROBERT
PRIMARY EXAMINER

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TECHNICAL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#4
**ELECTION
PATENT**

S. Bryce
12/31/03

Application No.: 10/066,519

Filing Date: January 31, 2002

Applicant: Walters, et al.

Group Art Unit: 3732

Examiner: Anu Ramana

Title: APPARATUS AND METHOD FOR MANIPULATING A
FLEXIBLE STRAND AND SOFT TISSUE
REPLACEMENT DURING SURGERY

Attorney Docket: 5490-000269

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and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

~~2/31/2003 SBRyce 00000002 080750 10066519~~

~~01 FC:1253 950.00 CR~~

Sir:

In response to the Restriction Requirement dated September 30, 2003, for which the time period to respond extends to December 30, 2003, Applicants elect claims of Group III (Claims 37-46), with traverse.

The Examiner is requested to reconsider the Restriction Requirement since it appears that the subject matter defined within all the groups of claims are similar.

Consequently, the field of search for each group should be essentially coextensive. Thus,

Adjustment date: 08/04/2004 EEKUBAY1
~~12/31/2003 SBRyce 00000002 080750 10066519~~
~~01 FC:1253 950.00 CR~~